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JUN 19 2002
TRADEMARK OFFICE

Docket No.: 50429-281

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Akihiko TAKABATAKE, et al.

Serial No.: 08/908,599

Group Art Unit: 2613

Filed: August 08, 1997

Examiner: Y. Lee

For: PICTURE DECODING & DISPLAY UNIT INCLUDING A MEMORY HAVING
REDUCE STORAGE CAPACITY FOR STORING PIXEL DATA

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PETITION TO THE COMMISSIONER UNDER 37CFR 1.181(a)(3)

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Commissioner for Patents
Washington, DC 20231

AUG 26 2002

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

Sir:

For reasons explained more fully below, petition is hereby made to invoke the supervisory authority of the Commissioner in application number 08/908,599 to withdraw the Office Action, dated May 2, 2002, to reinstate the Appeal (Notice of Appeal filed May 17, 2000, Brief filed August 17, 2000, October 3, 2000), to reinstate previously rejected claims 1 through 3 for consideration on their merits as being drawn to the elected invention, to hold dependent claims 4 through 7 as drawn to the elected invention and thus appropriate for consideration on their merits, and to direct the Examiner to respond appropriately to the Appeal Brief, either by Examiner's Answer and/or allowance of claims on appeal.

Claims 1 through 10 were the subject of the Appeal. Of these claims, Claims 1 and 8 are independent. Claims 2 through 7 depend, directly or indirectly, from claim 1. Claims 9 and 10 depend from claim 8.

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This application has a protracted history. In a non-final Office Action, dated August 6, 1999, claims 1 through 3 were under 35 U.S.C. §112 and claims 8 through 10 were rejected under 35 U.S.C. §102(e); claims 4 through 7 and other claims were withdrawn. A Response to that Office Action, filed November 5, 1999, traversed these rejections, as well as the Examiner's reading of claims on the various species. In an Office Action, dated November 18, 1999, claims 1 through 3 were withdrawn from consideration as being directed to a non-elected invention and the rejection of claims 8 through 10 was repeated. This action was made final and appeal was taken therefrom.

The withdrawal of claims 1 through 3 occurred only upon the final rejection, leaving petitioner no real opportunity to respond to the newly applied election requirement, similar to an earlier requirement which was traversed, made with respect to claims 1 through 3. Petitioner has maintained that claims 1 through 7 are readable on Fig. 12, the same figure upon which rejected claims 8 through 10 are readable and, therefore, appropriate for consideration on Appeal.

This issue of whether claims 1 through 7 are drawn to the elected invention, it is submitted, is a substantive issue based on the merits of the claim subject matter and, therefore, appropriate for decision on appeal, rather than on petition. The Examiner's refusal to permit this issue to be decided by Appeal, however, is a procedural issue that is subject to decision on petition. The rejection of claims 1 through 3 prior to the final Office Action, under the second paragraph of 35 U.S.C. §112, was made apparently for the reason that the Examiner was unable to read the language of independent claim 1 on the elected invention (see, for example, the Office Action dated April 15, 1997). No other explanation was given for concluding that the claims fail to meet the statutory requirements of 35 U.S.C. §112. The Examiner thus ambiguously held,

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inferentially but not explicitly, that claims 1 through 3 were not drawn to the elected species of invention.

Appellant traversed the rejection on the basis that the statement of the rejection in the Office Action does not purport that the subject matter recited in these claims cannot be understood, but rather that they are not readable on the elected species of invention. Yet the claims were rejected, as opposed to having been held withdrawn as readable on a non-elected species. It was submitted that the procedure undertaken in the Office Action is inappropriate to support the position taken. It was urged that the claim recitations not only meet the requirements of 35 U.S.C. §112, but also are readable on the elected species of the invention. Had the Office Action, instead, withdrawn claims 1 through 3, that response would have included a traversal of the holding based on the same reasons submitted therein. The response was not concerned with whether or not the requirement for election from among the various drawings is proper, but instead urged that the Examiner's holding that claims 1 through 3 are not readable on the elected species Figs. 11-15 is improper, an issue grounded in the substantive merits of the claims. Petitioner submits, therefore, that this issue is appropriate for decision on Appeal.

If, in the alternative, the Commissioner finds it appropriate to decide the issue on petition, petitioner's position is as follows. The elected species (as described in the response of January 2, 1997) is readable on Figs. 11-15. Fig. 12 shows the time period T_d corresponding to one macro block line. Although the start timing of decoding a B picture is delayed by one macro block line period T_d relative to assertion of the signal PSYNC, the time difference between the start of decoding of the B picture and the reading of the decoded picture is one field time period plus one macro block line. The embodiment of Fig. 12 is an improvement of embodiment 1 and others, as

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described in the specification. That is, embodiment 2, to which it is urged claims 1 through 10 are drawn, indicates the time difference between the picture decoding start and the picture reading start. Delay of one macro block line is not singly employed in embodiment 2. Dependent claim 2 requires the one macro block line delay. Fig. 12 clearly indicates such relation. The B picture, I picture and P picture subject matter is clearly recited in independent claim 1.

The final Office Action simply withdrew the rejection of claims 1 through 3 and, instead, withdrew these claims from consideration as not being readable on the elected species. The Office Action did not address appellant's remarks, described above, which urged that claim 1 and its dependent claims are readable on the elected species. No explanation was given in the Office Action in support of the Examiner's holding. As the Office Action was made final, thereby closing prosecution, a traversal submitted under 37 CFR 1.116 was denied entry. The Office Action currently of record makes no response to that traversal nor to the detailed arguments presented in the Appeal Brief. In addition, the rejection of claims 8 through 10 has been merely repeated in a one sentence statement without addressing the substantive arguments in traversal of this rejection presented in the Appeal Brief!

It is respectfully urged that the Examiner's holding that claims 1 through 7 are drawn to a non-elected species is improper. Fig. 12 indicates that the period between PSYNC signals includes two field periods. The time at which decoding of block B2 starts is delayed a period T_d for one macro block line after the field period for displaying block B1 (ODD). That is, in response to reading the block B1 (ODD) for display, decoding of block B2 occurs but delayed by T_d . The last clause of claim 1 recites that the start of decoding of a subsequent frame occurs after

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reading and displaying the last field of the earlier frame. Dependent claim 2 further requires the one macro block line delay. Claims 3, 4 and 7 are dependent from claim 2. Claims 5 and 6 are dependent from claim 1. It is submitted, therefore, that claims 1 through 7 are readable on Fig. 12 and should not have been denied examination on their merits.

It is submitted that the extended delay in the prosecution of this application, which has occurred from a succession of inconsistent Office Actions, has been unreasonable. The further delay between the filing of the Appeal Brief on October 3, 2000 and the issuance of the Office Action on May 2, 2002, with absolutely no substantive response to the points made by applicant in the Appeal Brief and earlier responses, renders the entire Office Action history unconscionable and amounts to a denial of due process. The Examiner has not met the burden of establishing a basis for review of his decisions for denying patentability of claims 1 through 10. Petitioner seeks a determination of its position with respect to all issues raised with respect to the Examiner's denial of patentability by an appropriate reviewing authority, either the Board of Patent Appeals and Interferences or the Commissioner (or his appropriate designee).

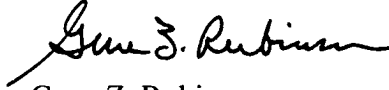
To avoid the possibility of incurring an extension of the period for response to the current Office Action of record while this petition is being considered, a Response to the Office Action is being filed herewith. The filing of this Response should not be taken as an indication that petitioner considers continued prosecution before the Examiner, without a determination by an appropriate reviewing authority, as an acceptable alternative to decision on this petition.

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Please charge any fee, if any is required, due in connection with the filing of this paper, to
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Respectfully submitted,

MCDERMOTT, WILL & EMERY

A handwritten signature in cursive script, reading "Gene Z. Robinson".

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